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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,945	07/10/2000	Tomoo Tsunenari	37B.P61	9915

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EXAMINER

POND, ROBERT M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 05/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/612,945

Applicant(s)

TSUNENARI, TOMOO 

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The Applicant amended Claims 1, 10, 15, 16, and 23. All pending claims, 1-27, were examined in this final office action.

Response to Arguments

The Applicants arguments are not persuasive. The Applicant argues that Junger prints return authorizations but does not disclose printing shipping labels.. This examiner takes the position that given the amount of effort expended by Junger to disclose a) properly documenting product returns, b) creating and printing return authorization label(s) to be placed on the package to be shipped, and c) shipping packages or pallets containing returned product with multiple return authorization labels, conveys that Junger is practicing a notoriously well-known method of shipping an item from an originating location to a destination location. A notoriously well-known method and commonly practiced method instituted by the postal service, carriers, couriers, shippers, or other transportation service providers is to require a delivery destination address so that the transportation service knows where to deliver the package. Given that Junger provides ample disclosure regarding automation (e.g. the printing of return authorization labels), one of ordinary skill in the art would surmise that shipping labels are being printed to support commonly known and practiced

shipping methods. This examiner further maintains that it is notoriously well-known and a commonly practiced method to print the shippers name and other information on the shipping label. For example, Bain et al., patent number 5,315,508 (24 May 1994), discloses shipping product to a delivery destination address and the creation of shipping labels that include carrier information (see at least Fig. 2). Webber, Jr., patent number 6,167,378 (26 December 2000) discloses shipping product to a delivery destination, affixing shipping labels to the package, the shipper transmitting its shipping labels to the party requiring the product to be shipped (see at least col. 12, lines 53-59).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 1. Claims 1-6, 8, 10-13, 15-18, and 22 are rejected under 35 USC 102(e) as being anticipated by Junger, patent number 6,085,172.**

Junger teaches all the limitations of Claims 1-6, 8, 10-13, 15-18, and 22. For example, Junger discloses a system and method for efficient handling of product

Art Unit: 3625

return transactions comprising at least two computers, a web server and a client computer, using the Internet, web interfaces, and email to effect consumer product returns through retailers to manufacturers, to distributors, or a regional retailer location (please see at least abstract; Fig. 2 (21, INTERNET, 23); col. 1, line 15 through col. 5, line 23). Junger teaches collecting product serial number information to uniquely identify returned product, a database for storing information, identifying destination locations, supplying a description of the returned product, and an operatively connected printer that prints shipping labels from the client computer (see at least Fig. 2 (216); col. 2, lines 14-38; col. 8, lines 50-54). Junger further teaches product return transportation, a truck or other means of transportation, for moving returned product from retailer locations to a returns processing facility (see at least Fig. 1 Prior Art (7); col. 4, lines 4-6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 7, 9, 19, and 20 are rejected under 35 USC 103(a) as being unpatentable Junger, patent number 6,085,172, in view of Official Notice**

regarding recyclable products, hereafter referred to as "ON1," and PR Newswire (PTO-892 Item: U).

Junger teaches all the above as noted under the 102(e) rejection but does not disclose a returned product being a recyclable product destined for a recycling facility. This examiner takes the position that the system and method of Junger applies equally to recyclable products eligible for return through a retailer or distributor, i.e. a defective recyclable product would be eligible for return or exchange by most retailers. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Junger to include recyclable products as taught by ON1, in order to better serve consumers who need to return recyclable products.

Junger and ON1 teach all the above as noted under the 103(a) rejection but do not disclose laser printer ink cartridges as a recyclable product, and returning a recyclable product to a recycling destination. PR Newswire teaches an interactive web site (www.etcep.com) for participants to recycle inkjet and laser cartridges. PR Newswire further teaches 243 million printer cartridges thrown away each year with an aggregate value of \$550 million, and a recycling program as a way for schools to collect used cartridges to be sent to a recycler, and earn points toward future technology purchases for schools. PR Newswire teaches the interactive web site as allowing participants to perform all functions necessary to return used printer cartridges (see page 1). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and

method of Junger and ON1 to include laser printer ink cartridges as taught by PR Newswire, in order to support environmental programs.

- 3. Claim 14 is rejected under 35 USC 103(a) as being unpatentable over Junger, patent number 6,085,172, in view of Gralla (PTO-892, page 2, Item: V).**

Junger teaches all the above as noted under the 102(e) rejection and further teaches collecting information via a web interface, but does not disclose the use of a cookie to pass or collect information from the client. Gralla teaches the use of cookies by Internet web sites to pass and collect information from a web client computer. Gralla teaches cookies as bits of data being deposited on a client's hard disk when visiting the web site, and the cookie being used to convey information to the server. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Junger to use the cookie to transmit information to the client computer as taught by Gralla, in order to make it easier to conduct electronic business with the web server.

- 4. Claim 21 is rejected under 35 USC 103(a) as being unpatentable over Junger, patent number 6,085,172, ON1 regarding recyclable product, and PR Newswire (PTO-892 Item: U), as applied to Claim 20 above, and further in view of Katayanagi et al., patent number 6,321,983.**

Junger, ON1, and PR Newswire teach all the above as noted under the 103(a) rejection, but do not disclose the use of a chip adapted to a printer cartridge to collect product information. Katayanagi et al. teach an IC chip storage device that adapts to products to help manage the life cycle of the product, spanning manufacturing through disposal. Katayanagi et al. further teach the device's usefulness to recyclers. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Junger, Official Notice, and PR Newswire to include a chip adapted to a product as taught by Katayanagi et al., in order to facilitate efficient product return and recycling processes.

- 5. Claims 23-27 are rejected under 35 USC 103(a) as being unpatentable over Junger, patent number 6,085,172, in view of Official Notice regarding program code, hereafter referred to as "ON2."**

Junger teaches all the above as noted under the 102(e) rejection and further teaches a manufacturer's computer that processes return requests providing a web page but does not teach program code as being implemented throughout the system. This examiner takes the position that computer program code is required for computer-automated tasks as disclosed by Junger, else the method of processing consumer returns via the Internet would not function. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention

Art Unit: 3625

to disclose program code at taught by ON2, in order to more fully describe how computers interact with each other to facilitate product returns.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

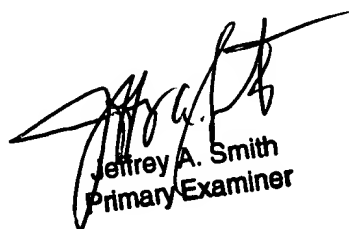
Washington D.C. 20231

or faxed to:

703-305-7687 (Official communications; including After Final
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, 7th floor receptionist.

RMP
May 13, 2003



Jeffrey A. Smith
Primary Examiner